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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,416	12/20/1999	PIETER DE HAAN	0/97286US	2292

31846 7590 05/20/2003

INTERVET INC
405 STATE STREET
PO BOX 318
MILLSBORO, DE 19966

EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 05/20/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/446,416

Applicant(s)

HAAN ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: The functional statement set forth in a "whereby" clause does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Mason, 244 F.2d 733, 114 USPQ 127 (CCPA 1957). The examiner suggests "wherein." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear to the examiner how the door closes. The examiner read the specification and found on page 5 a door assembly that is capable of closing the preloading section, but the specific structure and function or method of operating is missing or unclear.

The examiner reminds the applicant that no new matter should be entered.

2. Claims 1 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. By amending the specification to add "or manually" opening the door, the applicant has added new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph because the examiner is not sure if the door is being positively recited or used as function language.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 5, 7, 8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaldany (USPN 5562613).

Kaldany discloses a preloadable implantation device comprising a needle (104), a body (16) and an elongated part, a plunger (108), the periphery of the plunger defining a channel, a chamber (104b) and a door (102, 102a, 104). (Figures 3, 6, 7, 8, 9, 10 and entire reference)

Wherein the needle is chamfered. (Figures 9, 10)

Wherein the outside is closed after preloading. (Figures 3,6)

7. Claims 1, 3, 5, 7, 8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by J. Muir (USPN 1655158).

Muir discloses a preloadable implantation device comprising a needle, and an elongated part, a plunger, the periphery of the plunger defining a channel, a chamber and a door (Ref #. 20, 23, 24). (Figures 1-10 and entire reference)

Wherein the needle is chamfered. (Figures 4-9)

Wherein the outside is closed after preloading. (Figures 4-8)

Claim Rejections - 35 USC § 103

8. Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir as applied to claims 1, 3, 5, 7, 8, 11, 12 above, and further in view of Wiegerinck.

Muir discloses the claimed invention but fails to disclose the implant is a hormonal implant.

Wiegerinck (USPN 5405324) discloses the implant as a hormonal implant.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine Muir with Wiegerinck because it is well known in the medical art to use different types of medication with different types of applications, such as using hormonal pills or tablets, as stated in Wiegerinck. (Column 1, lines 1-25)

Therefore, it would have been obvious to combine the teachings of Muir with Wiegerinck to obtain the invention as specified in claims 1, 3-9.

9. Claims 1, 3-8, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaldany as applied to claim 1, 3, 5, 7, 8, 11, 12 above, and further in view of Wiegerinck.

Kaldany discloses the claimed invention but fails to disclose the implant is a hormonal implant.

Wiegerinck (USPN 5405324) discloses the implant as a hormonal implant.

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine Kaldany with Wiegerinck because it is well known in the medical art to use different types of medication with different types of applications, such as using hormonal pills or tablets, as stated in Wiegerinck. (Column 1, lines 1-25)

Therefore, it would have been obvious to combine the teachings of Kaldany with Wiegerinck to obtain the invention as specified in claims 1, 3-9.

Response to Arguments

10. Applicant's arguments filed 5/13/03 have been fully considered but they are not persuasive.

11. The examiner is unclear how the door is claimed because the door is not positively recited; it is unclear to the examiner due to the way the door is claimed. The examiner is also unclear to how the door works. How does the door automatically close? Since there is no further features or further information given to the door in the specification, the examiner is confused.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1-703-308-0858.



Matthew DeSanto
Art Unit 3763
May 19, 2003



BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700